

Express Mailing Label No. 511845130US
U. S. Patent Application No. 10/031,876
Amendment Dated December 13, 2004
Reply to Office Action Dated August 11, 2004

REMARKS

Claims 1, 2, and 5-7 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,354,142 to Nothhelfer et al (Nothhelfer) in view of U.S. Patent No. 5,373,729 to Seigeot (Seigeot) and U.S. Patent No. 5,182,076 to de Seroux et al. (de Seroux). Claims 3 and 4 are allowed. The Examiner admits that none of the references alone teaches the claimed invention of any of the claims. Nevertheless, the Examiner maintains that claims 1, 2, and 5-7 are obvious over a combination of references.

Claim 1 is directed to a foil leak detection chamber including an edge zone which can be evacuated independent of a test chamber. Claim 5 is a method for using a foil leak detection chamber including the step of evacuating an edge zone so that a holding force between frames of the chamber is sufficient to eliminate a need for an outside holding force. New claim 9 is directed to a foil leak detection apparatus including a biasing mechanism which biases foil frames apart and being operational in a mode in which closing force opposing a force of the biasing mechanism is created by evacuating the edge zone.

Nothhelfer, the primary reference, describes a foil leak detection chamber having a test chamber and an edge zone that is evacuated simultaneously and in a dependent manner.

According to MPEP §2143, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references, when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

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Regarding claim 1, claim 1 stands rejected over the combination of Nothhelfer, Seigeot, and de Seroux et al. In an Office Action response dated December 3, 2003 applicants argued that the Examiner's rejection of claim 1 was improper, in part, because Nothhelfer teaches away from the claimed invention and further because a modification of Nothhelfer in accordance with the claims would change the principle of operation of Nothhelfer.

In an office action dated February 26, 2004, the Examiner attempted to address (insufficiently in applicants' view) applicants' "teaching away" argument, but did not consider the applicants' argument that a modification of Nothhelfer would change the principle of operation of Nothhelfer.

In an Office Action response dated May 26, 2004, Applicants further argued that if the teachings of Nothhelfer and Seigeot were combined, a test chamber would presumably be defined by a combination of a bell shaped cover and a conveyor belt. Applicants herein incorporate their arguments presented in the responses of December 3, 2003 and of May 26, 2004.

In response to the Applicants arguments of May 26, 2004, the Examiner argued, in an Office Action dated August 11, 2004 that "as the applicants are aware, references need not be physically combined in order to show obviousness under 35 U.S.C. §103(a)." In support of the above argument the Examiner cited MPEP 2145, sec. III.

The Examiner's characterization of the applicants' May 26, 2004 arguments is inaccurate and the Examiner has misapplied MPEP 2145, sec. III. MPEP 2145, sec. III states:

"The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference....Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." *In re Kellar*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). See also *In re Sneed*, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir.

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1983) (“[I]t is not necessary that the inventions of the references be physically combinable to render obvious the invention under review.”); and *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973) (“Combining the teachings of references does not involve an ability to combine their specific structures.”).

However, the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. See MPEP §2143.01.

MPEP 2145, sec. III is in support of the principle that the incapacity of references to be physically combined does not establish non-obviousness. However, the applicants have not argued that Nothhelfer and Seigeot cannot be physically combined (applicants may argue this in the future). Applicants have merely argued that if Nothhelfer and Seigeot were combined, their combination would result in a structure other than the claimed invention. Applicants’ combinational-related arguments of May 26, 2004 were presented for, among other reasons, the following two reasons: (1) to further evidence that combination of Nothhelfer and Seigeot would change the principle of operation of; and (2) to further evidence that the combination of Nothhelfer and Seigeot, even if proper, would result in a structure that did not include all of the elements of the claimed invention. References when combined must teach all of the claim limitations, *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In reviewing the Examiner’s Office Actions, the applicants note that the Examiner has not attempted to respond to the applicants’ argument that the combination of Nothhelfer and Seigeot would change the principle of operation of Nothhelfer, thereby indicating that the Examiner is in agreement with the applicants that a modification of Nothhelfer in accordance with the claims would change the principle of operation of Nothhelfer. In the response dated December 3, 2003 applicants argued that a modification of Nothhelfer in accordance with the claimed invention would change the principle of operation of Nothhelfer, in that Nothhelfer teaches a test chamber in which a test is performed by simultaneously evacuating a test chamber and an area that could be considered an edge zone. Modification of Nothhelfer in a manner to arrive at the claims would necessarily involve a change in this basic principle of operation.

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The Examiner must address all of the applicants' arguments in support of patentability. Where the applicants traverse any rejection, the Examiner should if he or she repeats the rejection, take note of the applicants' argument and answer the substance of it. MPEP §707(f).

Regarding claim 5, the Examiner has failed to explain any reason why he believes the prior art references alone or in combination teach step (d) evacuating said edge zone so that a holding force between said frames is sufficient to eliminate a need to apply an outside holding force to hold said frames together.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 10 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Circ. 1988). See MPEP §2143.03.

The Examiner rejects claim 5 over the combination of Nothhelfer, Seigot, and de Seroux. However, none of the references teach or suggest evacuating said edge zone so that a holding force between said frames is sufficient to eliminate a need to apply an outside holding force to hold said frames together. Nothhelfer does not even teach an edge zone as recited by the applicants in claim 5, and therefore cannot be said to teach or suggest evacuating said edge zone so that a holding force between said frames is sufficient to eliminate a need to apply an outside holding force to hold said frames together. In Seigot, the cover 5, which the Examiner alleges is similar to a foil, is moved up and down by a drive means 6. Thus, Seigot cannot be said to supply motivation for evacuating said edge zone so that a holding force between said frames is sufficient to eliminate a need to apply an outside holding force to hold said frames together. de Seroux does not even teach a leak detection chamber and therefore cannot seriously be taken to provide motivation for evacuating said edge zone so that a holding force between said frames is sufficient to eliminate a need to apply an outside holding force to hold said frames together. While motivation to modify may be, in theory, alleged to be provided by other than the teachings of relied upon references the

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Examiner has provided no explanation for why a skilled artisan would be motivated to perform element (D) of claim 5 and other elements of claim 5.

At least because the Examiner has failed to even consider the claim element of claim 5 of evacuating said edge zone so that a holding force between said frames is sufficient to eliminate a need to apply an outside holding force to hold said frames together, the Examiner has failed to establish a *prima facie* case of obviousness as to claim 5. Accordingly, the rejection of claim 5 should be withdrawn. Claims 6-7 dependent on claim 5 are believed to be allowable for the reason that they depend on an allowable base claim and for the additional combinations of elements they recite. Claim 7 has been amended per the Examiner's suggestion.

New claim 9 recites combinations of elements not taught or suggested in the cited prior art and should be allowed. For example claim 9 recites a biasing mechanism normally biasing frames of a foil chamber apart. Claims 10-13 dependent on claim 9 are believed to be allowable at least for the reason they depend on an allowable base claim and for the additional combinations of elements they recite.

It is believed the present amendments and remarks place the application in condition for allowance. Accordingly, in view of the above amendments and remarks, Applicants believe the specification and claims of the present application to be in condition for allowance and respectfully request reconsideration and passage to allowance of the application.

If the Examiner believes that contact with Applicants' attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call Applicants' attorney at the number noted below.

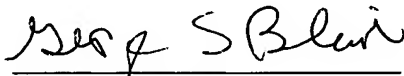
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The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to Deposit Account No. 50-0289.

Respectfully submitted,

WALL MARJAMA & BILINSKI LLP

Date: December 13, 2004



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